

REMARKS

This is in full and timely response to the Office Action mailed on August 13, 2004. Reexamination in light of the amendments and the following remarks is respectfully requested.

Claims 1-11 are currently pending in this application, with claims 1, 5, 6, 10 and 11 being independent.

No new matter has been added.

New non-final Office Action

If the allowance of claims 1-11 is not forthcoming at the very least and a new grounds of rejection made, then a **new non-final Office Action** is respectfully requested at least for the following reasons.

Rejection under 35 U.S.C. §103

Claims 1-11 were rejected under 35 U.S.C. §103 as allegedly being obvious over U.S. Patent Application No. 2003/0216993 to Goldwerger et al. (the Goldwerger Application Publication) in view of U.S. Patent No. 6,429,810 to De Roche (the De Roche Patent).

This rejection is traversed at least for the following reasons.

“The Patent and Trademark Office (PTO) has the burden of showing a prima facie case of obviousness.” *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). “In determining the propriety of the Patent Office case for prima facie obviousness, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the

art to suggest making the proposed substitution or other modification.” *In re Taborsky*, 502 F.2d 775, 780-81, 183 USPQ 50, 55 (CCPA 1974). Moreover, *prima facie* obviousness of a claimed invention is established “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The term “prior art” as used in section 103 refers at least to the statutory material named in 35 U.S.C. §102. *Riverwood International Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003)(citing *In re Wertheim*, 646 F.2d 527, 532, 209 USPQ 554, 560 (CCPA 1981)).

Moreover, the 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions >if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph<. M.P.E.P. §21363.03(III).

The above-identified application is entitled to benefit of the filing date of Japanese Patent Application No. 2000-098555. This Japanese Patent Application has a priority date of March 31, 2000. *A copy of an English Translation for Japanese Patent Application No. 2000-098555 has been filed on November 12, 2004*. M.P.E.P. §201.15.

The Goldwerger Application Publication published on November 20, 2003. However, the publication date for the Goldwerger Application Publication of November 20, 2003 is later than the priority date for the Japanese Patent Application of March 31, 2000.

The Goldwerger Application Publication is an application filed on November 27, 2002. However, the filing date for the Goldwerger Application Publication of November 27, 2002 is later than the priority date for the Japanese Patent Application of March 31, 2000.

The Goldwerger Application Publication is a continuation-in-part (the Goldwerger CIP) of application No. 09/665,291 filed on September 20, 2000. However, the filing date for the Goldwerger CIP application of September 20, 2000 is later than the priority date for the Japanese Patent Application of March 31, 2000.

The Goldwerger CIP appears to claim the benefit of provisional application No. 60/154,773 (the Goldwerger Provisional Application). The filing date for the Goldwerger Provisional Application of September 20, 1999 is earlier than the priority date for the Japanese Patent Application of March 31, 2000.

The Office Action cites paragraph [0010] of the Goldwerger Application Publication, contending that the Goldwerger Application Publication teaches a method that is processed to be electronic information capable of being mutually communicated by means of communication network lines (Office Action at page 3). However, the Office Action has failed to show that the Goldwerger Provisional Application properly supports this subject matter within the Goldwerger Application Publication relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

The Office Action cites paragraph [0006] of the Goldwerger Application Publication, contending that a method within the Goldwerger Application Publication teaches a shipping instruction processing step of instructing delivery of the consigned cargo to the destination collectively including a physical distribution trader by accessing a specific side (Office Action at page 3). However, the Office Action has failed to show that the Goldwerger Provisional Application properly supports this subject matter within the Goldwerger Application Publication relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

The Office Action cites paragraph [0105] of the Goldwerger Application Publication, contending that the Goldwerger Application Publication teaches a physical distribution expense calculation processing step of calculating physical distribution expenses necessarily for delivery of the cargo to the distribution (Office Action at page 3). However, the Office Action has failed to

show that the Goldwerger Provisional Application properly supports this subject matter within the Goldwerger Application Publication relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

Thus, the Office Action has failed to show the availability of the Goldwerger Application Publication as prior art for the subject matter relied upon to make the rejection.

The Office Action contends that calculating physical distribution expenses necessary for delivery of the cargo to the destination is found within the Goldwerger Application Publication.

Moreover, the Goldwerger Application Publication arguably teaches a report 500 that also may include, e.g., a calculated offer average 510, providing an average price, time frame, and container size for recent prior offers 506 (Goldwerger Application Publication at paragraph [0065]).

The Goldwerger Application Publication arguably teaches that the report 500 also may include a calculated service contract average 512, providing an average for the information shown in relation to recent prior service contracts 508 (Goldwerger Application Publication at paragraph [0065]).

The Goldwerger Application Publication arguably teaches that a report 600 also may include a calculated average 610, providing, e.g., an average price or time frame included with all summarized offers submitted to the shipper 102 (Goldwerger Application Publication at paragraph [0070]).

The Goldwerger Application Publication arguably teaches that the report 600 may also include, e.g., a calculated average 612, providing the average container size included in all summarized tender line items submitted by the shipper 102 (Goldwerger Application Publication at paragraph [0070]).

The Goldwerger Application Publication arguably teaches that the Make an Offer section 1038 allows the carrier to submit and offer on the selected tender line item, and may comprise data

fields, pull-down, scrolling or pop-up menus, check-boxes, check-circles, a Submit button and/or other sections for entering the price (e.g., total price or price per container), currency, price components, transit time and indicating whether rail is used or not (Goldwerger Application Publication at figure 10e, paragraph [0105]).

However, the Office Action has failed to show that the Goldwerger Application Publication teaches calculating physical distribution expenses necessary for delivery of the cargo to the destination.

In addition, the Office Action has failed to show the availability of the Goldwerger Application Publication as prior art for calculating physical distribution expenses necessary for delivery of the cargo to the destination.

Also note that the Goldwerger Application fails to show *determining a cargo transportation route in conformity with said shipping instruction on a basis of said shipping instruction information and said transport schedule*.

In addition, the Office Action has failed to show the availability of the Goldwerger Application Publication as prior art for *determining a cargo transportation route in conformity with said shipping instruction on a basis of said shipping instruction information and said transport schedule*.

The Office Action admits that the Goldwerger Application Publication does not teach a cargo tracking processing step of indicating delivery status of the cargo, and cites the De Roche Patent for this step (Office Action at page 3).

In response, the De Roche Patent issued on August 6, 2002. However, the issue date for the De Roche Patent of August 6, 2002 is later than the priority date for the Japanese Patent Application of March 31, 2000.

The De Roche Patent is based upon an application filed on January 31, 2001. However, the filing date of January 31, 2001 for the application that matured into the De Roche Patent is later than the priority date for the Japanese Patent Application of March 31, 2000.

The De Roche Patent appears to claim priority of Provisional Patent Application Serial Nos. 60/179,536, 60/228,100 and 60/242,355. In this regard, the De Roche Provisional Patent Application Serial No. 60/228,100 of August 28, 2000 and the De Roche Provisional Patent Application Serial No. 60/242,355 of October. 23, 2000 are later than the priority date for the Japanese Patent Application of March 31, 2000.

The filing date for De Roche Provisional Patent Application Serial No. 60/179,536 of February 1, 2000 is earlier than the priority date for the Japanese Patent Application of March 31, 2000.

The Office Action cites the Abstract and column 2, lines 11-14 of the De Roche Patent teach an automated cargo tracking system comprising of communication and sensor unit affixed to the container to be tracked during shipping, proving the shipper and/or forwarder with accurate, timely, cargo status (Office Action at page 3). However, the Office Action has failed to show that De Roche Provisional Patent Application Serial No. 60/179,536 properly supports this subject matter within the De Roche Patent relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

Thus, the Office Action has failed to show the availability of the De Roche Patent as prior art for the subject matter relied upon to make the rejection.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753 or the undersigned attorney at the below-listed number.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: March 31, 2005

Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorney for Applicant